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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,969	07/07/2000	PETER MORITZ	P00.1252	4636

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EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 10/03/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,969

Applicant(s)

MORITZ, PETER

Examiner

Wen-Tai Lin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 July 2000 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 12-25 are presented for examination.
2. Claims 13-16 are objected to because the term "the telecommunication terminal equipment" in claims 13 and 15 appears to lack antecedent basis.
3. Claims 19, 21 and 23-25 are objected to because of the following issues/informalities:
 - (i) As to claims 19 and 21 line 2, it is not clear whether the "charge proposal" is the same as the "proposal" of claim 18 (line 2). If so, then the "second part" at line 3 of both claims appears to be a typo of the "first part" because the proposal in claim 18 is sent from the second part of the service logic and is supposed to be received by the first part of the service logic.
 - (ii) As to claim 23, it is not clear what is meant by "uniform horizontal interface". That is, the specification does not appear to have a clear definition regarding this terminology. For purpose of prior art rejection in this office action, the "uniform horizontal interface" is construed as an "interface".Clarification/Correction is required in response to this office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 12-19 and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Nieminen et al.[WO-9800951].

6. Nieminen is cited from Applicant's IDS filed 7/6/2000.

7. As to claims 12-14, Nieminen teaches the invention as claimed including: a method for offering telecommunication service in an intelligent network comprised of a service logic [Fig.2], the method comprising:

- implementing a first part of the service logic within a central unit [4, Fig.2; page 3, lines 17-20; page 10, line 19 – page 12, line 12];
- implementing a second part of the service logic outside the central unit [1-2, Fig.2; page 3, lines 20-27],

wherein the second part of the service logic is implemented in the telecommunication terminal equipment of a service user and a connection exists between the first part of the service logic and the second part of the service logic [Abstract].

8. As to claims 15-16, Nieminen further teaches that the connection between the first part of the service logic and the second part of the service logic uses an existing connection of the telecommunication terminal equipment with the central unit or at least a part of the connection of the first part of the service logic and the second part of the service logic utilizes an ISDN connection [page 1, lines 20-24].

9. As to claims 17-18, Nieminen further teaches that charge information is at least partly generated by the second part of the service logic, wherein the second part of the service logic sends a proposal for the charge information to the first part of the service logic, which then further processes the charge information [page 12, lines 30-35, wherein the charge information is related to the state/duration of connection].

10. As to claim 19, Nieminen further teaches that the first part of the service logic checks whether a charge proposal is acceptable when the charge proposal is received by the first part of the service logic, and initiates review of the second part of the service logic when a result of this check is positive [page 14, lines 10-12; e.g., the ISB checks the balance of the user's account at the request of the service provider].

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11. As to claim 21, Nieminen further teaches that the first part of the service logic checks whether a charge proposal is acceptable [e.g., whether the user has enough balance in his/her account] when the charge proposal is received by the first part of the service logic, and forwards the charge proposal to an entity responsible for billing when a result of this check is positive [page 13, lines 36-38].

12. As to claim 22, since the features of this claim can also be found in claims 12, it is rejected for the same reasons set forth in the rejection of claims 12 above.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieminen et al.(hereafter "Nieminen")[WO-9800951], as applied to claims 12-19 and 21-22 above.

15. As to claim 20, Nieminen does not specifically teach initiating the review of the second part of the service logic when the proposal for the charge information fails to arrive at the first part of the service logic.

However, Nieminen teaches that when a critical network error or a security break occur, the ISB may be arranged to terminate the ISB connection(s) and all currently active service programs [page 12 line 37 – page 13 line 12].

Thus, it is obvious to one of ordinary skill to have introduced a review process on the second part of service logic when the proposal for the charge information fails to arrive at the ISB, because failing to receive a charge information is an indication that a network error or security of breach may have occurred.

16. As to claims 23-24, Nieminen does not specifically teach using API or JTAPI to provide an interface for the exchange of IN messages between the first part of the service logic stored on the terminal equipment and the second part of the service logic stored in the central part of the intelligent network.

However, it is well known in the art that API or JTAPI are popular techniques for providing interfaces among distributed processes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply API or JTAPI in Nieminen's system these are proven techniques in a distributed server-client environment and by doing so it would enhance the efficiency of Nieminen's system.

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17. As to claim 25, since the features of this claim can also be found in claims 12-14, 16 and 22-23, it is rejected for the same reasons set forth in the rejection of claims 12-14, 16 and 22-23 above.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Nieminen et al. [U.S. Pat. No. 6578075];

Gish [U.S. pat. No. 6272555]; and

Teper et al. [U.S. pat. No. 5815665].

19. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (703)305-4875. The examiner can normally be reached on Monday-Friday(8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

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(703)746-5516 for status inquires draft communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Wen-Tai Lin

September 26, 2003

Wen-Tai Lin 9/26/03